

REMARKS

In response to the Final Office Action dated May 31, 2006, Applicant respectfully submits the present Amendment and Remarks.

As an initial matter, the undersigned would like to thank the Examiner for the courtesy of extending a telephone interview on July 11, 2006. During the interview, proposed amendment of the claims was discussed. The claims were proposed to be amended as suggested in the May 31, 2006 Office Action. As a result of the interview, Applicant has amended the claims as presented above to place the present application in condition for allowance. Accordingly, reconsideration is respectfully requested pursuant to 37 CFR 1.116.

Amendment to Specification

Page 15 of the specification has been amended to correct a typographical error to change "13mer" to "16mer." Support for this can be found throughout the specification, particularly at page 15 of the specification and in the original claims as filed. Specifically, this amendment has been made to clarify that SEQ ID NO.: 1 has 16mer. No new matter has been added. Thus Applicant respectfully request that this amendment be entered.

Amendment to Claims

Withdrawn claims 1-20 have been canceled. In addition, claims 29, 36, and 39 have also been canceled. Claims 21-28, 30-35, and 37-40 have been amended. Hence, claims 21-28, 30-35, and 37-40 are currently pending in this application. Claims 21-28, 30-35, and 37-40 have been amended to clearly define the subject matter of the claimed invention. Support for these claims can be found throughout the specification, particularly at page 15 of the specification and in the original claims

as filed. No new matter has been added. These claims do not require additional searches from the Examiner, and thus Applicant respectfully request that they be entered.

RESPONSE

In the Office Action, the Examiner maintained the rejection of claims 22-25, 27-31, and 33-35 under 35 U.S.C. §112, first paragraph alleging that the subject matter thereof does not enable a person skilled in the art to make and use the invention commensurate in scope with the claims when the specification is only enabled for "a fusion protein comprising an anti-idiotypic anti-CEA antibody fused to a peptide consisting of SEQ ID NO: 1." The Examiner alleges that it would require undue experimentation for one skilled in the art to practice the invention as claimed since the specification discloses "only anti-idiotypic antibody 3H1 that induces anti-CEA antibody fused to a peptide consisting of SEQ ID NO: 1." The Examiner also alleges that there is insufficient guidance to the structure of the claimed peptide in the specification. Allegation that there is "lack of guidance and working example to demonstrate that antibody comprises either light chain or heavy chain is capable of binding to any antigen" is also made in the Office Action.

The Examiner also maintained the rejection of claims 22-25, 27-31, and 33-35 under 35 U.S.C. §112, first paragraph, alleging that the subject matter thereof does not convey that the inventor had possession of the claimed invention at the time the application was filed. The Examiner further alleges that the specification does not provide an adequate written description of the claimed invention for the same reasons in making the §112, first paragraph rejection above.

In addition, the Examiner rejected claim 21-40 under 35 U.S.C. §112, first paragraph, alleging that the subject matter thereof does not convey that the inventor had possession of the claimed invention at the time the application was filed.

The Examiner also rejected claims 21 and 27-40 under 35 U.S.C. §112, second paragraph for being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In the Office Action, the Examiner indicated that these rejections would be obviated if the claims were amended to recite, e.g., "a light and heavy chain," "an antigen fragment thereof, "a specific anti-idiotpe antibody 3H1." In the interest of advancing the prosecution of the present application, Applicant has amended the claims as suggested by the Examiner, both as recited in the Office Action as well as during the interview.

Hence, in view of the canceled and amended claims, Applicant respectfully submits that the specification provides the necessary guidance to apply the invention to various combinations of peptides and antibodies under the practice of the invention. The specification of the invention clearly provides an enabling disclosure for one of skill in the art to make a fusion protein using a myriad of combinations.

For at least the reasons detailed above, Applicant respectfully submits that the application as filed provides the guidance that permits one skilled in the art to make and use the invention as claimed. Applicant respectfully submits that the specification need not, and indeed preferably does not, exemplify all possible embodiments of the invention. Rather, the specification need only provide the necessary guidance to the skilled artisan in order to allow them to make and use the

invention. Applicant respectfully submits that he has more than adequately provided such guidance in the present application.

As the specification is fully supportive of the invention as presently claimed, and the pending claims, as amended, clearly point out and distinctly claim the subject matter which Applicant regards as the invention, Applicant respectfully requests the Examiner reconsider and withdraw the rejections under 35 USC §112, first and second paragraphs.


CONCLUSION

In light of the foregoing amendments and remarks, Applicant respectfully submits that the application is now in condition for allowance. Should any minor matter remain, or should the Examiner feel that an interview would expedite the prosecution of this application, the Examiner is invited to call the undersigned at his convenience.

To the extent necessary, Applicant petitions for an extension of time under 37 CFR 1.136. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to the Antonelli, Terry, Stout & Kraus, LLP Deposit Account No. 01-2135 (Docket No. 411.35629PC2), and please credit any excess fees to such Deposit Account.

Respectfully submitted,

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